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PATENT

Technology Center 2100

- 1 -



CR9-99-045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	:	Before the Examiner:
John R. Hind et al.	:	Baum, Ronald
Serial No.: 09/316,804	:	Group Art Unit: 2131
Filed: May 21, 1999	:	
Title: METHOD AND APPARATUS	:	IBM Corporation
FOR INITIALIZING MOBILE	:	P.O. Box 12195
WIRELESS DEVICE	:	Dept. T81/503
	:	Research Triangle Park, NC 27709

REQUEST FOR REINSTATEMENT OF APPEAL

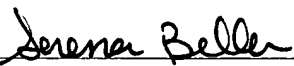
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Action (Paper No. 15) having a mailing date of August 18, 2004, reopening prosecution of the above-referenced Application, Applicants respectfully request reinstatement of the Appeal based on the Appeal Brief filed on May 17, 2004 and the Notice of Appeal filed on March 26, 2004.

CERTIFICATION UNDER 37 C.F.R. §1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on October 18, 2004.



Signature

Serena Beller

(Printed name of person certifying)

A supplemental appeal brief is filed herewith.

FEE DEFICIENCY

NOTE: If there is a fee deficiency and there is no authorization to charge an account, additional fees are necessary to cover the additional time consumed in making up the original deficiency. If the maximum, six-month period has expired before the deficiency is noted and corrected, the application is held abandoned. In those instances where authorization to charge is included, processing delays are encountered in returning the papers to the PTO Finance Branch in order to apply these charges prior to action on the cases. Authorization to charge the deposit account for any fee deficiency should be checked. See the Notice of April 7, 1986, 1065 O.G. 31-33.

- ☒ If any additional extension and/or fee is required, this is a request therefor and to charge Account No. 09-0461 (CR9-99-045).

AND/OR

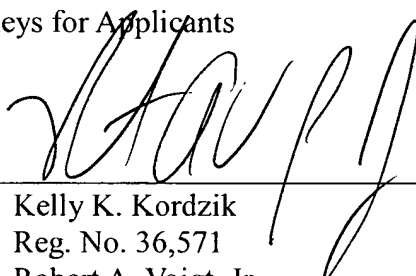
- ☒ If any additional fee for claims is required, charge Account No. 09-0461 (CR9-99-045).

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Applicants

By: _____


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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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Filed: May 21, 1999	:	
	:	IBM Corporation
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FOR INITIALIZING MOBILE	:	Dept. T81/503
WIRELESS DEVICE	:	Research Triangle Park, NC 27709

SUPPLEMENTAL APPEAL BRIEF

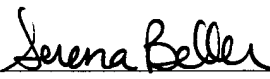
Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This supplemental brief is being submitted pursuant to 37 C.F.R. §41.37.

CERTIFICATION UNDER 37 C.F.R. §1.8

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Signature

Serena Beller

(Printed name of person certifying)

I. INCORPORATION BY REFERENCE

Appellants hereby incorporate herein by reference Sections I-V and VIII-IX of Appellants' Brief mailed on May 17, 2004.

II. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 2-4, 6, 8-10, 12, 14-16 and 18-22 stand rejected under 35 U.S.C. §112, second paragraph. Claims 2-3, 8-9, 14-15 and 19-21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Debry (U.S. Patent No. 6,314,521). Claims 4, 10 and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Debry in view of "Netscape Certificate Server FAQ", 1997 (hereinafter "Netscape").

IV. ADDITIONAL ARGUMENT

A. Claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are not properly rejected under 35 U.S.C. §112, second paragraph.

The Examiner has rejected claims 2-4, 6, 8-10, 12, 14-16 and 18-22 under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential elements. Paper No. 15, page 4. In particular, the Examiner states:

Claims 2-4, 6, 8-10, 12, 14-16, 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP §2172.01. The omitted elements are: 'using said embedded radio modules' as the return communications path; (claim 2, 8, 14, and claims 3, 4, 19, 9, 10, 20, 15, 16, 21 by dependence) 'returning from said first device, a unique device identifier of said first device, to said server', (claim 6, 12, 18, and claim 22 by dependence) 'returning from said first device a unique device identifier and said public key of said first device to said server', 'transmitting said device certificate and a public key of a Certificate Authority which signed said device certificate to said first device.' Paper No. 15, page 4.

The Examiner further states:

Claims 2-4, 6, 8-10, 12, 14-16, 18-22 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural

cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP §2172.01. The omitted structural cooperative relationships are: 'wherein said protective storage is write-only storage able to perform computations involving previously-written data' (claims 2, 6, 8, 12, 14, 18 and claims 3, 4, 19, 9, 10, 20, 15, 16, 21, 22 by dependence), whereas the use of 'write-only storage' that although it is recited in the claim as storage (protected), at the same time it is expected to be 'able to perform computations'. This is clearly an inconsistency in either the art per se, or is an implementation omission. Paper No. 15, page 4.

Appellants respectfully traverse and assert that claims 2-4, 6, 8-10, 12, 14-16 and 18-22 do not omit matter disclosed to be essential to the invention as described in the Specification. Accordingly, claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are allowable under 35 U.S.C. §112, second paragraph.

Appellants respectfully assert that the phrase "using said embedded radio modules" is not an essential element omitted from claims 2, 6, 8, 12, 14 and 18. In fact, the phrase has been inserted in these claims. For example, in claim 2 it recites "sending an inquiry from said server to said first device using said embedded radio modules." Hence, the allegedly essential element has not been omitted from claims 2, 6, 8, 12, 14 and 18.

Furthermore, if the Examiner is asserting that the above-cited phrase needs to be cited in conjunction with the other limitations in claims 2, 6, 8, 12, 14 and 18 since it is necessary to have an embedded radio module to accomplish those limitations, Appellants respectfully traverse. The Examiner has not cited to any reference in the Specification that indicates that "using embedded radio modules" is necessary and essential to accomplish particular limitations in claims 2, 6, 8, 12, 14 and 18. According to M.P.E.P. §2172.01, a claim which omits matter disclosed to be essential to the invention as described in the Specification may be rejected under 35 U.S.C. §112, first paragraph. M.P.E.P. §2172.01 further states that a claim which fails to interrelate essential elements of the invention as defined by applicant(s) in the

Specification may be rejected under 35 U.S.C. §112, second paragraph. The Examiner has not pointed to any reference in the Specification which indicates that "using embedded radio modules" is necessary and essential to accomplish particular limitations in claims 2, 6, 8, 12, 14 and 18. Accordingly, the Examiner has not provided any evidence to support his rejection of claims 2-4, 6, 8-10, 12, 14-16 and 18-22 under 35 U.S.C. §112, second paragraph, pursuant to M.P.E.P. §2172.01 (the section the Examiner is relying upon to reject claims 2-4, 6, 8-10, 12, 14-16 and 18-22 under 35 U.S.C. §112, second paragraph). Accordingly, claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are allowable under 35 U.S.C. §112, second paragraph.

Furthermore, according to M.P.E.P. §706.03(d), the basis of a 35 U.S.C. §112, second paragraph, rejection is whether the scope of the claimed subject matter cannot be determined by one having ordinary skill in the art. Appellants respectfully assert that the limitations of claims 2-4, 6, 8-10, 12, 14-16 and 18-22 can be determined by one having ordinary skill in the art. Consequently, Appellants respectfully assert that claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are allowable under 35 U.S.C. §112, second paragraph.

Appellants respectfully assert that the phrase "wherein said protected storage is write-only storage able to perform computations involving previously-written data" is not an essential element omitted from claims 2, 6, 8, 12, 14 and 18. In fact, the phrase has been inserted in these claims. For example, in claim 2 it recites "wherein said protected storage is write-only storage able to perform computations involving previously-written data." Hence, the allegedly essential element has not been omitted from claims 2, 6, 8, 12, 14 and 18.

Furthermore, if the Examiner is asserting that the above-cited phrase cannot be determined by one having ordinary skill in the art, Appellants respectfully traverse. Appellants kindly direct the Board's attention to page 14, lines 14 –17 of the Specification, which describes, in part, a write-only storage means, such that there is

no way for software residing in the device to read a key but the device can execute operations against the information. The cited passage in the Specification further describes an example where an operation on a protected value is a digital signature operation using a private key value. Hence, the Specification describes a protected storage that stores information, e.g., a key, that can be used to perform computations but cannot be read and written over. It is noted that this interpretation is illustrative and that Appellants are not limited to this interpretation. A rejection under 35 U.S.C. §112, second paragraph, is not appropriate, when the scope of the claimed subject matter can be determined by one having ordinary skill in the art. M.P.E.P. §706.03(d). One having ordinary skill in the art can determine the scope of the claimed subject matter, including the phrase "wherein said protected storage is write-only storage able to perform computations involving previously-written data." Consequently, Appellants respectfully assert that claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are allowable under 35 U.S.C. §112, second paragraph.

B. Claims 4, 10 and 16 are not properly rejected under 35 U.S.C. §103(a) as being unpatentable over Debry in view of Netscape.

The Examiner has rejected claims 4, 10 and 16 under 35 U.S.C. §103(a) as being unpatentable over Debry in view of Netscape. Paper No. 15, page 8. The reference Debry, which may qualify as prior art under 35 U.S.C. § 102(e), does not preclude patentability under 35 U.S.C. §103 since Debry and the claimed invention in claims 4, 10 and 16 were at the time the invention was made, subject to an obligation of assignment to the same person, which in this case was International Business Machines Corporation. 35 U.S.C. §103(c). Thus, Debry is disqualified as being used as a prior art reference under 35 U.S.C. §103(c). Consequently, the rejections of claims 4, 10 and 16 are moot.

V. CONCLUSION

For at least the reasons stated above and in the Appeal Brief filed by Appellants on May 17, 2004, the rejections of claims 2-4, 6, 8-10, 12, 14-16 and 18-22 are in error. Appellants respectfully request reversal of the rejections and allowance of claims 2-4, 6, 8-10, 12, 14-16 and 18-22.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellants

By: _____

Robert A. Voigt, Jr.

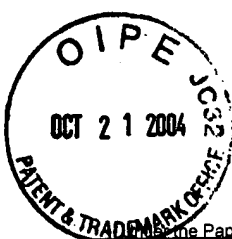
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PTO/SB/21 (08-03)

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**TRANSMITTAL
FORM**

(to be used for all correspondence after initial filing)

Application Number	09/316,804
Filing Date	May 21, 1999
First Named Inventor	John R. Hind et al.
Art Unit	2131
Examiner Name	Ronald Baum
Attorney Docket Number	CR9-99-045

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ENCLOSURES (Check all that apply)

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| <input type="checkbox"/> Response to Restriction Requirement | <input type="checkbox"/> Petition | <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) |
| <input type="checkbox"/> After Final | <input type="checkbox"/> Petition to Convert to a Provisional Application | <input type="checkbox"/> Proprietary Information |
| <input type="checkbox"/> Affidavits/declaration(s) | <input type="checkbox"/> Power of Attorney, Revocation | <input type="checkbox"/> Status Letter |
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Remarks

Supplemental Appeal Brief

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Winstead Sechrest & Minick P.C. Robert A. Voigt, Jr. Reg. No. 47,159
Signature	
Date	October 18, 2004

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Typed or printed name	Serena Beller		
Signature		Date	October 18, 2004

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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